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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,990

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Michael Offenhuber

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RONALD E. GREIGG
GREIGG & GREIGG P.L.L.C.
1423 POWHATAN STREET, UNIT ONE
ALEXANDRIA, VA 22314

EXAMINER

TRAN, BINH Q

ART UNIT

PAPER NUMBER

3748

MAIL DATE

DELIVERY MODE

12/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,990	Applicant(s) OFFENHUBER ET AL.	
	Examiner BINH Q. TRAN	Art Unit 3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the amendment filed August 29, 2008.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 8-26 are rejected under 35 U.S.C. 102 (b) as being anticipated by Tarabulski et al. (Tarabulski) (Patent Number 6,063,350).

Regarding claims 8 and 26, Tarabulski discloses an apparatus for introducing a reducing agent (30) containing urea into the exhaust (20) of an internal combustion engine (10), the

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apparatus comprising a reservoir (e.g. 30, 130), a delivery unit (32), a flow path (31, 131) for the reducing agent, the flow path leading from the reservoir (30) to the delivery unit (32), a ventilation device (e.g. 135, 155) for ventilating at least one region of the flow path (31, 131), the ventilation device being disposed in the flow path and being situated at a geodetic high point of the flow path (See Figs. 1-2), and a ventilation being disposed in the flow path, and a ventilation opening in the ventilation device that always permits a return of a minimal fluid quantity to the reservoir and a ventilation return line (e.g. 31', 31'', 33, 133) connecting the ventilation opening and the reservoir (e.g. See col. 7, lines 17-67; col. 8, lines 1-28).

Regarding claim 9, Tarabulski further discloses wherein the ventilation device comprises a float valve (155) (e.g. See col. 7, lines 17-67; col. 8, lines 1-28).

Regarding claim 10, Tarabulski further discloses wherein the ventilation device includes a solenoid valve (e.g. See col. 7, lines 17-67; col. 8, lines 1-28).

Regarding claim 11, Tarabulski further discloses wherein the ventilation device comprises a flow throttle (e.g. See col. 7, lines 17-67; col. 8, lines 1-28).

Regarding claims 12-15, Tarabulski further discloses a filter, and wherein the ventilation device is situated in the filter or in close proximity to the filter (e.g. See col. 7, lines 17-67; col. 8, lines 1-28).

Regarding claims 20-25, Tarabulski further discloses wherein the ventilation device is situated upstream of the delivery unit (e.g. See col. 7, lines 17-67; col. 8, lines 1-28).

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarabulski in view of Tokuda, and further in view of design choice.

Regarding claims 16-19, Tarabulski discloses all the claimed limitation as discussed above except the filter is able to operate in two different installation positions that differ from each other by approximately 90° and wherein the ventilation device is situated at an angle of approximately 45° between the two installation positions.

Regarding the specific range of the filter and ventilation device positions, it is the examiner's position that a range approximately 90° of the filter position and an angle of approximately 45° of the ventilation device, would have been an obvious matter of design choice well within the level of ordinary skill in the art, depending on variables such as mass flow rate of the exhaust gas, as well as the concentration and temperature of reducing agent in the exhaust gas, properties of materials for making the NO_x storage catalyst, and the controlled temperature of the catalytic converter. Moreover, there is nothing in the record which establishes that the claimed parameters present a novel or unexpected result, and such modification, i.e. choosing from a finite number of predictable solutions, is not of innovation but of ordinary skill and common sense. (See *KSR International Co. v. Teleflex Inc.*, 550 U.S.--, 82 USPQ2d 1385 (April 30, 2007)).

Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. In *re Dreyfus*, 22 CCPA (Patents) 830, 73 F.2d 931, 24 USPQ 52; In *re Waite et al.*, 35 CCPA (Patents) 1117, 168 F.2d

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104, 77 USPQ 586. Such ranges are termed "critical" ranges, and the applicant has the burden of proving such criticality. In re Swenson et al., 30 CCPA (Patents) 809, 132 F.2d 1020, 56 USPQ 372; In re Scherl, 33 CCPA (Patents) 1193, 156 F.2d 72, 70 USPQ 204. However, even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art. In re Sola, 22 CCPA (Patents) 1313, 77 F.2d 627, 25 USPQ 433; In re Normann et al., 32 CCPA (Patents) 1248, 150 F.2d 627, 66 USPQ 308; In re Irmischer, 32 CCPA (Patents) 1259, 150 F.2d 705, 66 USPQ 314. More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Swain et al., 33 CCPA (Patents) 1250, 156 F.2d 239, 70 USPQ 412; Minnesota Mining and Mfg. Co. v. Coe, 69 App. D.C. 217, 99 F.2d 986, 38 USPQ 213; Allen et al. v. Coe, 77 App. D.C. 324, 135 F.2d 11, 57 USPQ 136.

Response to Arguments

Applicant's arguments filed August 29, 2008 have been fully considered but they are not completely persuasive. ***Claims 8-26 are pending.***

Applicant's cooperation in explaining the claims subject matter more specific to overcome the claim rejection is appreciated.

Applicant's arguments with respect to claims 8-26 have been considered but are moot in view of the new ground(s) of rejection as discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Binh Tran whose telephone number is (571) 272-4865. The examiner can normally be reached on Monday-Friday from 8:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion, can be reach on (571) 272-4859. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/BINH Q. TRAN/

Binh Q. Tran
Primary Examiner, Art Unit 3748
December 06, 2008